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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,412	03/30/2001	Eleanor S. Wilson	85SF-00110	3204
23465 7590 07/14/2008 JOHN S. BEULICK C/O ARMSTRONG TEASDALE, LLP ONE METROPOLITAN SQUARE SUITE 2600 ST LOUIS, MO 63102-2740				
EXAMINER COLBERT, ELLA				
ART UNIT 3696		PAPER NUMBER		
NOTIFICATION DATE 07/14/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

# Office Action Summary

**Application No.**

09/681,412

**Applicant(s)**

WILSON ET AL.

**Examiner**

Ella Colbert

**Art Unit**

3696

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 and 45-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 45-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/IC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-20 and 45-53 are pending. Claim 11 has been amended in this communication filed 4/01/08 entered as Response After Non-Final Action and Request for Extension of Time.
2. The 35 USC 112, second paragraph rejection of claim 11 has been overcome by Applicants' amendment to claim 11 and is hereby withdrawn. The 35 USC 112, Second paragraph rejections for claim 1 and 45 still remain as set forth here below.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "a financing requirement it is unclear from the claim limitation what applicant's "financing requirement" entails and what the requirement is from the claim language. Claims 11 and 45 have a similar problem. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim 1, also recites "analyzing the information ...; and recommending to the customer ...". It is unclear and vague who or what is analyzing the information and doing the recommending to the customer ...". Is the potential lender for the loan or the computer performing these steps? Claims 11 and 45 have a similar problem.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 11-17, 45-48 rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,940,812) Tengel et al, hereafter Tengel.

Claims 1, 11, and 45. Tengel discloses, A method for operating a computer to facilitate a choice of a financing product, said method comprising the steps of: prompting a customer to provide information related to a financing requirement (col. 7, lines 1-5, col. 8, line 37-col. 9, line 22, fig. 4 and fig. 5); prompting the customer to input into the computer information describing the energy-related asset being financed, wherein the energy –related asset including at least one of a power generating facility, a refinery, a mine, and a pipeline (col. 8, line 37-col. 9, line 22, fig. 4 –“no. 14 other unique attribute” and fig. 5); prompting the customer to input the computer responses to a plurality of questions regarding the at least one requirement for financing the energy-related asset; analyzing the information inputted into the computer by the customer (col. 9, lines 11-54); recommending to the customer based on the analyzed information a type of financing for financing the energy related asset, wherein the financing types include a financing project, a high yield debt, leasing, a project common equity, a limited partnership, a private equity and a preferred equity (col. 9, line 55-col. 10, line 56 and Fig. 6-other unique attributes). Tengel did not expressly disclose the “a power

generating facility, a refinery, a mine, and a pipeline, a financing project, a high yield debt, leasing, a project common equity, a limited partnership, a private equity and a preferred equity". However, these are a design choice and simply attributes as well as being non-functional descriptive claim language. Nonfunctional descriptive claim language is not accorded patentable weight.

Claims 11 and 45 are rejected for the similar rationale as given above for claim 1.

Claims 2, 12, and 46. Tengel discloses, further comprising the step of evaluating by the computer a financing type selected by the customer; and determining whether the selected financing type is the recommended financing type (col. 9, line 32- col. 10, line 56).

7. Claims 3-10, 13-20, 47-53 rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,940,812) Tengel et al, hereafter Tengel in view of US 7,177,834) Maestle.

.Claims 3, 13, and 47. Tengel failed to disclose, evaluating by the computer a financing type selected by the customer including a project common equity; accessing an equity valuation tool when the customer inputs project common equity as the financing type; calculating and equity valuation using the equity valuation tool and information inputted by the customer, wherein the calculated equity valuation relates to the energy-related asset. Maestle discloses, evaluating by the computer a financing type selected by the customer including a project common equity (col. 55, lines 8-43); accessing an equity valuation tool when the customer inputs project common equity as the financing type (col. 56, lines 5-67); calculating and equity valuation using the equity

valuation tool and information inputted by the customer, wherein the calculated equity valuation relates to the energy-related asset (col. 57, line 1-col. 58, line 53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Maestle in Tengel because such a combination would allow Tengel to have a financial model specifically for the project being prepared.

Claims 4, 14, and 48, Tengel failed to disclose, a project common equity financing type selection, prompting the customer to provide describing the energy-related asset including an energy output of the asset. Maestle discloses, a project common equity financing type selection, prompting the customer to provide describing the energy-related asset including an energy output of the asset (col. 91, line 23-col. 92, line 65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Maestle in Tengel because such a modification would allow Tengel to give the age of the property, the location of the property, the condition of the property and the purchase price of the property in order to be provided a loan to purchase the property and to use the property as collateral for the loan.

Claims 5 and 15. Tengel failed to disclose, wherein the energy-related asset is a power generation plant, the information provided by the customer describing the energy-related asset includes power plant information, current financing information, projected electricity prices. Maestle discloses, wherein the energy-related asset is a power generation plant, the information provided by the customer describing the energy-related asset includes power plant information, current financing information,

projected electricity prices (col. 93, line 40-col. 97, line 50). A power plant is a design choice. The current financing information provided by the customer describing the energy related asset including power plant information, current financing information, and projected electricity prices can be for anything. For example, a loan for a car or a home or a warehouse or a commercial property.

Claims 6, 16, and 50. Tengel failed to disclose, wherein default values are available for at least one of projected electricity prices and projected fuel costs, when specific values are not provided. Maestle discloses, wherein default values are available for at least one of projected electricity prices and projected fuel costs, when specific values are not provided (col. 103, line 1-col. 109, line 65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Maestle in Tengel because such a combination would allow Tengel to have set default values when an estimate is being made and the specific costs are not known or accessible.

Claims 7 and 17. Tengel discloses, further comprising the step of displaying a computer generated screen describing a selected financing type (col. 4, lines 41-45 and col. 5, lines 20-28).

Claims 8, 18, and 51. Tengel discloses, wherein prompting the customer to input responses comprises the steps of: displaying a computer generated screen listing a plurality of background questions relating to the financing requirement; and displaying a computer generated screen listing a plurality of financing specific questions (col. 4, line 53-col. 5, line 2, col. 8, lines 50-65, and col. 9, lines 12-31).

Claims 9, 19, and 52. Tengel failed to disclose, wherein the background questions relating to the financing requirement comprise at least one of the country where financing is required, which energy related business is the financing for, is the financing required for an operating asset, are U.S. taxes currently being paid by the customer, is the customer interested in either of off-balance sheet or non-recourse financing, and is the customer interested in structured debt such as high yield debt or subordinated debt. Maestle discloses, wherein the background questions relating to the financing requirement comprise at least one of the country where financing is required, which energy related business is the financing for, is the financing required for an operating asset, are U.S. taxes currently being paid by the customer, is the customer interested in either of off-balance sheet or non-recourse financing, and is the customer interested in structured debt such as high yield debt or subordinated debt (col. 14, line 6-col. 26, line 61). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Maestle in Tengel because such a combination would allow Tengel to have a financial model specifically for the project being prepared.

Claims 10, 20, 53. Tengel failed to disclose, wherein the financing specific questions comprise at least one of amount of financing, selling or optimizing equity position, willing to share control, upside potential and residuals of the asset, willing to subordinate equity distribution to a preferred equity investor, willing to be contacted regarding the financing, early stage pre-IPO company or company in early



stage of corporate cycle and interested in financing senior to common equity but junior to lenders and trade creditors. Maestle discloses, wherein the financing specific questions comprise at least one of amount of financing, selling or optimizing equity position, willing to share control, upside potential and residuals of the asset, willing to subordinate equity distribution to a preferred equity investor, willing to be contacted regarding the financing, early stage pre-IPO company or company in early stage of corporate cycle and interested in financing senior to common equity but junior to lenders and regarding the financing, early stage pre-IPO company or company in early stage of corporate cycle and interested in financing senior to common equity but junior to lenders and trade creditors (col. 110, lines 43-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Maestle in Tengel because such a combination would allow Tengel to have a financial model specifically for the project being prepared.

Claim 49. Tengel and Maestle failed to disclose, Apparatus according to Claim 48 wherein the energy-related asset comprises a power generating facility, and the information provided by the customer describing the energy-related asset includes plant size, a heat rate, a percentage of revenues under contract, a number of years remaining under contract, a remaining term of the existing debt, an outstanding principal, interest rate, electricity prices and an annual rate of increase, and projections of prices and projected fuel costs including an escalator. The claim limitation of this claim contains nonfunctional descriptive claim language and is therefore not accorded patentable weight.

***Response to Arguments***

Applicants' arguments filed 4/01/08 have been fully considered but they are not persuasive.

Issue no. 1: applicants' argue: The rejection of claims 1, 11, and 45 under 35 USC 112, second paragraph as being indefinite is respectfully traversed because the specification clearly describes, and the figures show, what is meant by a "financing requirement" and the Office action asserts the recitations of "analyzing the information ... and recommending to the customer ... are unclear and vague as to who or what is analyzing the information and doing the recommending to the customer. Applicants' respectfully submit that the originally filed specification fully describes a system that analyzes information provided by the customer and recommends financing options to the customer based on the information that claims 1, 11, and 45 are definite and particularly point out and distinctly claim the subject matter of the invention has been considered but is not persuasive. Response: The Examiner respectfully disagrees that the claims particularly point out and distinctly claim the subject matter of the invention. Resort can be had to case law as follows: "However, the written description is not a substitute for, nor can it be used to rewrite the chosen claim language. Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment. *Resonate Inc. v. Alton Websystems, Inc.*, 67 USPQ2d 1771 (Fed. Cir. 2003).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Issue no. 2: Applicants' argue: Applicants' respectfully submit that Tengel does not describe or suggest the claimed invention and Tengel does not describe or suggest prompting a customer to input into a computer information describing an energy-related asset includes a power generating facility, a refinery, a mine, and/or a pipeline has been considered but is not persuasive. Response: The type of information the customer inputs is given very little patentable weight because it is considered "non functional descriptive material that cannot render nonobvious an invention that would have otherwise been obvious". *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ 2d, 1862, 1864 (Fed. Cir. 2004). *In re Gulak*, 703 F.2d 1381, 1385, 217 USPQ401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Statements of intended use do not serve to distinguish structure over the prior art. See *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); *In re Yanush*, 4778 F.2d 958, 959, 152 USPQ 235, 238 (CCPA 1967).

Issue no. 3: Applicants' argue: Applicants' traverse the assertion at page 3 of the Office Action that Tengel describes "prompting the customer to input into the computer information describing the energy-related asset being financed, wherein the energy-related asset including at least one of a power generating facility, a refinery, a mine, and a pipeline has been considered but is not persuasive. This has been addressed above in Issue no. 2. Furthermore, Tengel is analogous art since Applicants' are applying for a loan to finance an asset and matching the loan to the requirements of the applicants' for

the financing. What is being financed does not change the procedure for financing and making the loan.

Issue no. 4: Applicants' argue: Applicants' respectfully submit Maestle does not make up for the deficiencies of Tengel and as discussed does not describe or suggest the limitations of claims 3-10, 13-20, and 47-53 has been considered but is not persuasive. Response: It is interpreted that Tengel and Maestle disclose and suggest the claim limitations since both references are considered analogous art. Resort can be had to case law as follows: "[t]he suggestion or motivation to combine references does not have to be stated expressly; rather it may be shown by reference to the prior art itself, to the nature of the problem solved by the claimed invention, or to the knowledge of one of ordinary skill in the art." *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 68 USPQ2d 1263 (Fed. Cir. 2003). Also, see *In re Dembiczak*, 50 USPQ2d 1614, *In re Nilssen* (CAFC) 7 USPQ 2d 1500 (7/13/1998), *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983) and *In re McLaughlin*, 443, F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

"Analogous art is that which is relevant to consideration of obviousness under 35 USC 103, and relevant criteria in determining whether prior art is analogous to the claimed subject matter are whether art is from the same field of endeavor, regardless of the problem addressed, and if not, whether it is still reasonably pertinent to a particular problem to be solved." *Wang Lab., Inc. v. Toshiba Corp.*, 26 USPQ 2d 1767 (Fed. Cir. 1993).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

#### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

July 7, 2008

**Application Number****Application/Control No.**

09/681,412

**Applicant(s)/Patent under  
Reexamination**

WILSON ET AL.

**Examiner**

Ella Colbert

**Art Unit**

3696